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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/626,430

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David F. Bantz

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EXAMINER

LEZAK, ARRIENNE M

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/626,430

Applicant(s)

BANTZ ET AL.

Examiner

Arrienne M. Lezak

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Examiner notes that Independent Claims 1, 25-27 and 35 have been amended, no new Claims have been added and no claims have been cancelled. All claims not explicitly addressed herein are found to be addressed within prior Office Action dated 16 September 2003 as reiterated herein below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 25, 26, 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,812,533 to Cox. Cox discloses a system and method for service provisioning a customer with at least one software application from a service provider, comprising the steps of establishing a set of attributes of the service provision, (Col. 1, lines 6-12 and 31-43); selecting from said set of attributes for defining a Service Level Agreement (SLA) with the service provider; and provisioning the customer in accordance with constraints imposed by the SLA, (Col. 3, lines 52-63; Col. 45, lines 23- 67; Col. 46, lines 1-37). Cox further discloses a method for transparently and flexibly re-provisioning the customer as needed, per the SLA, (Col. 4, lines 17-23, Col.5, lines 13-16, Col. 7, lines 6-16) and the use of a virtual service provider, (Col. 15,

lines 10-60). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 25, 26, 35 and 36.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-20, 24-26, 28-33, 35, and 36 are rejected under 35 U.S.C. 103(a) as obvious over Cox ('533). Cox is relied upon for the teachings as discussed above relative to Claims 1-4, 10-17, 21-27, 30 and 34-36 as found herein. In the alternative, Cox is further interpreted to disclose those limitations not specifically enumerated within Cox, which include the originations or destinations of data processing resource allocation or re-allocation, the attribute options, the use of a value-added services provider, or Internet (e-marketplace) application, (as required by Claims 5-20, 24-26, 28-33, 35, and 36 of the pending application).

6. To use the specifically enumerated originations or destinations for data processing resource allocation or re-allocation, the attribute options, the use of a value-added services provider, or the Internet (e-marketplace) application, (as stated in the pending application), within the Cox system and method for service provision in communication networks, would have been obvious to one of ordinary skill in this art at the time of invention by applicant, as examiner believes these limitations to be obvious when considered in light of Cox ('533).

7. The motivation to include all types and combinations of origination and destination data processing resources for the purposes of allocation and re-allocation is found within Cox as suggested by the need for flexibility in service provision, (Col. 1, lines 31-43; Col. 45, lines 23-28). A communications network, such as the one disclosed in Cox is not limited in its use of data processing resources, which in this case Examiner believes to include those resources deemed necessary to facilitate network activity, which is inclusive but not limited to customer data processing task requests.

8. The motivation to include all types of attribute options within Cox is suggested by the functionality comprising a service directory defining the one or more selected services available to that user, (Col. 3, lines 52-63) and the customer profile as defined by the rules, attributes and features that apply network wide, (Col. 43, lines 19-22; Col.42, lines 39-42). As Cox indicates the non-specific use of attributes, Examiner believes that the Cox attributes would be inclusive of those attributes specifically enumerated within the pending application.

9. The motivation to use a value-added service provider within Cox is suggested by the need for a service provider to be able to offer services, which are introduced quickly and flexibly, without undue delay or cost, (Col. 1, lines 24-27). Inclusive and obvious to a concern over cost would be the option to utilize a value-added service provider whenever permitted.

10. The motivation for an Internet application of Cox is suggested by reference to networks, particularly virtual networks, as indicated above. Moreover, the use of a virtual network as applied to the Internet was obvious at the time of the Cox application, as the Internet network was inexistence and capable for use as applied to Cox. Examiner further acknowledges that the communications network described is applicable to any network offering a variety of services to

the customer while being able to add or modify the portfolio of services available, (Abstract).

Thus, application of the same to the provision of services, (as applied to software), would be obvious and inherent.

11. Thus, Claims 5-20, 24-26, 28-33, 35, and 36 are unpatentable over the teachings of Cox ('533).

12. Claims 27-34 and 36-40 are rejected under 35 U.S.C. 103(a) as obvious over Cox ('533) in view of US Patent 5,748,896 to Daly. Cox, again, is relied upon for the teachings as discussed above relative to Claims 1-4, 10-17, 21-27, 30 and 34-36. Though Cox discloses the incorporation of management aspects, (Col. 1, line 42-43), an alternative interpretation indicates the disclosure of limitations not specifically enumerated within Cox, such as the utilization of a system management server, personal computers, or the Internet (as required by Claims 27-34 and 36-40 in the pending application).

13. Daly ('896) discloses a system and method for managing network services which employs the use of a system management server in a computer network, (pending application p.4, lines 24-25; Daly ('896) Abstract and Col. 1, line 10), and the Internet, (Col.2, lines 50-67).

14. To use the system management server, computer network components and Internet applications of Daly within the service provision system and method of Cox would have been obvious to one of ordinary skill in this art at the time of invention by applicant, as indicated within Cox. The motivation to use a management server and computer network components within Cox is apparent by the incorporation of management aspects, (Col. 1, line 42-43), and computing platforms, (Col. 2, lines 42-48), into the aforementioned system and method. Further,

examiner believes the use of a management server and computers is inherent within the “intelligent network” described in Cox, (Col. 1, lines 6-12).

15. The motivation to apply the teachings of Cox to the Internet applications of Daly is the same as the motivation to incorporate Cox generally within Internet applications as indicated herein above. Moreover, Daly discloses the use of an email service, (Col. 2, line 67), which further implies an Internet application.

16. Therefore, Claims 27-34 and 36-40 are found to be unpatentable over Cox in view of Daly.

17. Examiner further acknowledges Applicants admission as to the teachings of Daly ('896) which “disclose a method for a management server to obtain information about service instantiations for the purposes of displaying the status of those instantiations on a management console, wherein the management server need not have been programmed to be aware of all of the types of services that it will actually deal with. This is achieved by storing service objects with the components of the service, these service objects being programmed to be aware of the specific service that the associated component can be used to instantiate. The sequestering of service-specific programming in these service objects permits the management server to be unaware of the details of the services it manages,” (pending application p.4, lines 23-33 and p.5, lines 1-3).

18. Examiner also acknowledges Applicants summary of what elements are missing from Daly ('896) which, when combined with Daly would anticipate the limitations of the pending application in its entirety. These elements, disclosed within Cox ('533), include the process and flexibility of instantiation of services, (Col.1, lines 31-43 and Col. 3, lines 46-51), the use of

subscriber specified service attributes, (Col. 3, lines 52-63 and Col. 42, lines 28-58), and the transparent re-instantiation of services, (Col. 5, lines 13-16 and Col. 15, lines 10-60). Examiner believes these limitations to be anticipated by the prior art as incorporated herein above.

19. Newly amended Claims 1 and 27 are further rejected under 35 U.S.C. 103(a) as obvious over Cox ('533) alone and in view of Daly ('896). Cox discloses a system and method for service provisioning a customer with at least one software application from a service provider, comprising the steps of establishing a set of attributes of the service provision, (Col. 1, lines 6-12 and 31-43); selecting from said set of attributes for defining a Service Level Agreement (SLA) with the service provider; and provisioning the customer in accordance with constraints imposed by the SLA, (Col. 3, lines 52-63; Col. 45, lines 23- 67; Col. 46, lines 1-37). Cox further discloses a method for transparently and flexibly re-provisioning the customer as needed, per the SLA, (Col. 4, lines 17-23, Col.5, lines 13-16, Col. 7, lines 6-16) and the use of a virtual service provider, (Col. 15, lines 10-60). Daly ('896) discloses a system and method for managing network services which employs the use of a system management server in a computer network, (pending application p.4, lines 24-25; Daly ('896) Abstract and Col. 1, line 10), and the Internet, (Col.2, lines 50-67).

20. Cox is further interpreted to disclose that limitation not specifically enumerated within Cox, which is the specific provisioning of at least one client computer of the customer. As noted herein above, Examiner acknowledges that the service provisioning enumerated herein are obviously applicable to any network offering a variety of services to the customer while being able to add or modify the portfolio of services available. Thus, application of the same to the provision of services throughout a network of client computers and software therefore, would

have been obvious at the time of invention by Applicant, and therefore unpatentable. Thus, newly amended Claims 1 and 27 and those claims dependent thereon, (namely Claims 2-4, 10-17, 21-24, 30 and 34) are further rejected.

Response to Arguments

21. Applicant's arguments filed 26 January 2004, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

22. In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the specific provisioning of at least one client computer of the customer") are not recited in the originally rejected claim(s) as enumerated within the prior Office Action dated 16 September 2003.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, newly amended Claims 1 and 27 are further rejected in their entirety as noted herein above. Moreover, Examiner notes that the non-substantive amendments made to Claims 25, 26 and 35 do not show how the amendments avoid original rejection of the same, and therefore are further rejected as noted herein. All Examiner responses comprise all argument disclosed herein relative to Cox and Cox in view of Daly.

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23. Applicant's argument regarding Claims 1, 6, 27, 35 and 36 are based on a portion of Cox ('533) which is not a part of the Cox invention, but rather a portion of the Background of the invention, (Col. 1, lines 59-64 and Col. 2, lines 1-5), which is therefore irrelevant and further rejected. Examiner disagrees with Applicant's interpretation of Cox, (and Cox in view of Daly, as noted herein above), and finds the same to be very specific in its application of Service Level Agreements to service provisioning as enumerated herein. Applicant's argument regarding Cox disclosing a telecommunications system as opposed to Applicant's data processing system is addressed herein above wherein Examiner further acknowledges that the communications network described (within Cox) is applicable to any network offering a variety of services to the customer while being able to add or modify the portfolio of services available, (Abstract). Thus, application of the same to the provision of data processing services would be obvious and inherent, and as such, Claims 1, 6, 27, 35 and 36 are further rejected.

24. Regarding Claims 5, 25 and 26, Applicant acknowledges that Cox discloses a resource allocator, however, Applicant argues the specific allocation of data processing resources, which has already been addressed herein above, and as such Claims 5, 25 and 26 are further rejected.

25. Regarding Claim 36, Applicant's acknowledgement of Cox disclosing a virtual network inherently implies the use of a virtual service provider, and thus Claim 36 is also rejected.

26. Regarding Claim 16, Examiner disagrees with Applicant and finds that the motivation to include all types of attribute options within Cox is suggested by the functionality comprising a service directory defining the one or more selected services available to that user, (Col. 3, lines 52-63) and the customer profile as defined by the rules, attributes and features that apply network wide, (Col. 43, lines 19-22; Col.42, lines 39-42). As Cox indicates the non-specific use of

attributes, Examiner believes that the Cox attributes would be inclusive of those attributes specifically enumerated within the pending application, and as such, Claim 16 is further rejected.

27. Regarding Claim 28, Examiner disagrees with Applicant and finds that the motivation to include all types and combinations of origination and destination data processing resources for the purposes of allocation and re-allocation is found within Cox as suggested by the need for flexibility in service provision, (Col. 1, lines 31-43; Col. 45, lines 23-28). A communications network, such as the one disclosed in Cox is not limited in its use of data processing resources, which in this case Examiner believes to include those resources, (both local and remote), deemed necessary to facilitate network activity, which is inclusive but not limited to customer data processing task requests. Thus, Claim 28 is further rejected.

28. Regarding Claim 33, Examiner disagrees with Applicant and finds that the use of a value-added service provider within Cox is suggested by the need for a service provider to be able to offer services, which are introduced quickly and flexibly, without undue delay or cost, (Col. 1, lines 24-27). Inclusive and obvious to a concern over cost would be the option to utilize a value-added service provider whenever permitted. Thus, Claim 33 is further rejected.

29. Regarding Claim 39, Examiner disagree with Applicant and finds that an Internet application of Cox is suggested by reference to networks, particularly virtual networks, as indicated above. Moreover, the use of a virtual network as applied to the Internet was obvious at the time of the Cox application, as the Internet network was inexistence and capable for use as applied to Cox. Further, as noted herein, Cox in view of Daly ('896) addresses Internet application of the same, specifically, Daly discloses the use of an email service, (Col. 2, line 67), which further implies an Internet application. Thus, Claim 39 is further rejected.

30. Thus, as Examiner has completely addressed Applicant's amendment, and finding Applicant's arguments do not show how Applicant's amendment avoids such references or objections, Examiner hereby maintains the original rejection of all claims, (both independent and dependent), in their entirety. Examiner has addressed Applicant's amendment, and has further rejected newly amended Claims 1, 25-27 and 35. Further, all dependent claims are again rejected as being reliant on independent claims rejected herein. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

31. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion


32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (703)-305-0717. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (703)-308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703)-305-3718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-6121.

Arrienne M. Lezak
Examiner
Art Unit 2143

AML



DAVID WILEY
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